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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,787	03/30/2001	Maureen McMahon	ROXIP204	7422

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EXAMINER

SELLERS, DANIEL R

ART UNIT	PAPER NUMBER
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2615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/823,787

Applicant(s)

MCMAHON ET AL.

Examiner

Daniel R. Sellers

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-5, 7-9, 15, and 17-26** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Regarding **claim 1**, the method for recording audio files to optical media recites is seemingly a patentable process, however, it is in reality seeking patent protection of a computer program in the abstract as evidenced by claim 10. Claim 1 does not provide positive recitation of a practical application by a physical transformation. Instead it states in the present progressive tense that recording is happening, and does not recite

Art Unit: 2615

an outcome of the recording. Claim 1 also does not currently produce a useful, concrete, and tangible result, because the outcome is uncertain.

5. **Claims 2-5 and 7-9** are non-statutory because they depend on claim 1 and they do not provide positive recitation of a practical application by a physical transformation that produces a useful, concrete, and tangible result.

6. **Claim 15** is non-statutory for the same reason as claim 1.

7. **Claims 17-20** are non-statutory because they depend on claim 15 and they do not provide positive recitation of a practical application by a physical transformation that produces a useful, concrete, and tangible result.

8. **Claim 21** is non-statutory because the claim does not fall within one of the statutory classes. The claimed subject matter falls under a Judicial Exception, wherein patent protection is sought for abstract ideas as program instructions as evidenced by the claim language. An example of acceptable language for claiming computer-processing related claims would be "a computer readable medium encoded with computer executable instructions, the computer readable medium comprising:", or the like. Claim 21 would also be acceptable if written in a similar form as claim 10.

9. **Claims 22-26** are non-statutory because they depend on claim 21.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 2615

11. **Claims 1-5, 7-15, and 17-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurpiers, the Nero Burning Rom 5.5 Review, and the Free Playlist Generator (hereinafter Kurpiers, Nero, and Generator, respectively).

12. Regarding **claim 1**, Kurpiers teaches a device that reads a CD with MP3 files and playlists (M3U files) (p. 42, Playlists and Programmes). Kurpiers does not teach the recording of the files to the optical media, however at the time of the invention no CD-ROMs are available with MP3 and M3U files pre-recorded.

Nero teaches initiating a project to record audio files to the optical media, the initiating of the project triggering a filtering to identify only MP3 files (p. 2-3, Standard Features; teaches that Nero can create Data and Audio CDs, and p. 4-5, Track View/Save Features; teaches that Nero can filter file names when ripping audio from a CD to a hard drive). It would be obvious to filter files when creating a CD. Nero inherently teaches the browsing of MP3 files at a source location, and selecting MP3 files to record to a destination optical media. Nero teaches the recording of selected MP3 files to the destination optical media, and in view of Kurpiers a user would select a Data CD project to record MP3 files and a M3U file to a CD. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Kurpiers and Nero for the purpose of creating a data CD with MP3 and M3U files. However, Nero does not teach the automatic construction of a playlist of the selected MP3 files, which does not require user interaction regarding creation of the playlist of the selected MP3 files.

The Generator teaches automatic construction of a playlist according to various different modes, wherein user interaction regarding the playlist is not required insofar as the Generator creates the M3U file in the proper format (i.e. it creates a plain text file with the proper format and pathnames to the audio files it refers to) (p. 1, paragraphs 2-3). The Generator also outputs a M3U file for later use (p. 1, paragraph 4). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Kurpiers, Nero, and the Generator for the purpose of creating a CD with a playlist suitable for selecting certain albums out of a several albums or for selecting songs that fit a certain mood.

13. Regarding **claim 2**, the further limitation of claim 1, the combination teaches selecting a MP3 project of a media recording application (Nero teaches a data CD project).

14. Regarding **claim 3**, the further limitation of claim 2, see the preceding argument with respect to claim 2. The combination teaches configuring the media recording application for a data recording session.

15. Regarding **claim 4**, the further limitation of claim 3, Kurpiers teaches a CD player OSCAR. OSCAR supports a Joliet format (see the included reference OSCAR User Manual Version A4, p. 3, bullet 7). Furthermore, Nero teaches a CD for PCs, which inherently supports the Joliet format (p.3).

16. Regarding **claim 5**, the further limitation of claim 2, the combination teaches the use of a graphical user interface (GUI) to display MP3 files for browsing and selecting.

Art Unit: 2615

17. Regarding **claim 7**, the further limitation of claim 1, the combination teaches editing the playlist prior to recording the selected MP3 files and playlist to the optical media.

18. Regarding **claim 8**, the further limitation of claim 7, the combination teaches a GUI for editing the playlist.

19. Regarding **claim 9**, the further limitation of claim 7, the OSCAR User Manual teaches that the playlist file, the M3U file, is comprised of just a list of file paths and file names pointing to the files for playback on the destination media (p. 16, "Playlists on CD ROM or hard disk (.M3U-Files)").

20. Regarding **claim 10**, see the preceding argument with respect to claim 1. The combination teaches a computer media with these features.

21. Regarding **claim 11**, the further limitation of claim 10, see the preceding argument with respect to claim 2. The combination teaches these features.

22. Regarding **claim 12**, the further limitation of claim 10, see the preceding argument with respect to claim 3. The combination teaches these features.

23. Regarding **claim 13**, the further limitation of claim 12, see the preceding argument with respect to claim 4. The combination teaches these features.

24. Regarding **claim 14**, the further limitation of claim 10, see the preceding argument with respect to claim 9. The combination teaches these features.

25. Regarding **claim 15**, see the preceding argument with respect to claim 1. The combination teaches these features.

Art Unit: 2615

26. Regarding **claim 17**, the further limitation of claim 15, see the preceding argument with respect to claim 9. The combination teaches these features.

27. Regarding **claim 18**, the further limitation of claim 15, see the preceding argument with respect to claim 5. The combination teaches these features.

28. Regarding **claim 19**, the further limitation of claim 15, see the preceding argument with respect to claim 5. The combination teaches these features.

29. Regarding **claim 20**, the further limitation of claim 15, the combination teaches M3U playlist files, wherein the building data structure includes keeping a list in memory of the selected particular ones of the MP3 files in an order in which they were selected.

30. Regarding **claim 21**, see the preceding argument with respect to claim 1. The combination teaches these features.

31. Regarding **claim 22**, the further limitation of claim 21, see the preceding argument with respect to claim 2. The combination teaches these features.

32. Regarding **claim 23**, the further limitation of claim 21, the combination teaches a GUI, see the preceding argument with respect to claims 1, 5, and 19.

33. Regarding **claim 24**, the further limitation of claim 21, see the preceding argument with respect to claim 9. The combination teaches these features.

34. Regarding **claim 25**, the further limitation of claim 24, see the preceding argument with respect to claim 7. The combination teaches these features.

35. Regarding **claim 26**, the further limitation of claim 25, it is *admitted prior art* that WinAmp provides the functions of importing a playlist and adding, or combining, another playlist.

Response to Arguments

36. Applicant's arguments with respect to claims 1-5, 7-15, and 17-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Van Ryzin, USPN 6,393,430;

Katinsky et al., USPN 6,452,609; and

Phillips et al., US PGPub 2002/0045960.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel R. Sellers whose telephone number is 571-272-7528. The examiner can normally be reached on Monday to Friday, 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571)272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DRS



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SUPERVISORY PATENT EXAMINER